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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/086,206	02/28/2002	Juana Magdalena	408.014-CON	1829
20311	7590	08/23/2007		
LUCAS & MERCANTI, LLP 475 PARK AVENUE SOUTH 15TH FLOOR NEW YORK, NY 10016			EXAMINER JOHANNSEN, DIANA B	
			ART UNIT 1634	PAPER NUMBER
			MAIL DATE 08/23/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Advisory Action</b> <b>Before the Filing of an Appeal Brief</b>	Application No. 10/086,206	Applicant(s) MAGDALENA ET AL.	
	Examiner Diana B. Johannsen	Art Unit 1634	

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 03 August 2007 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 4 months from the mailing date of the final rejection.  
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

#### AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
(a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);  
(b) ☐ They raise the issue of new matter (see NOTE below);  
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See attachment. (See 37 CFR 1.116 and 41.33(a)).

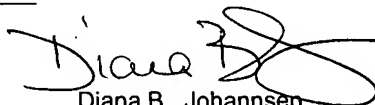
4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).  
5. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.  
6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.  
The status of the claim(s) is (or will be) as follows:  
Claim(s) allowed: 31, 32 and 34.  
Claim(s) objected to: 41 and 47-53.  
Claim(s) rejected: 28-30, 35-44, 47-51, 54 and 55.  
Claim(s) withdrawn from consideration: \_\_\_\_\_.

#### AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).  
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).  
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

#### REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:  
See Continuation Sheet.  
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). \_\_\_\_\_.  
13. ☐ Other: \_\_\_\_\_.

  
Diana B. Johannsen  
Primary Examiner  
Art Unit: 1634



Continuation of 11. does NOT place the application in condition for allowance ~~because~~ for the reasons of record in view of the non-entry of the after final amendment.

***Attachment to Advisory Action***

**1. Continuation of 3(a):**

a) Applicant's proposed amendments raise the following new issues that would require further search and consideration under 35 USC 102 and/or 35 USC 103. Applicant has proposed amending many of the claims to add the language "a complement" or to change the language "the complement" to "a complement" (see, e.g., claims 28-30, 35, 37, 38, 40, 41, 47, 49, 52, 55). Thus, the claims are no longer limited to a specific sequence or its complement; rather, the language "a complement" broadens the scope of the claims such that they encompass any molecule complementary to a recited SEQ ID NO (for example, where claims were previously limited to SEQ ID NO: 1 or "the complement" thereof [i.e., the single, complete complement of SEQ ID NO: 1), the claims would now encompass, e.g., a shorter sequence complementary to only a subsequence of SEQ ID NO: 1). Additionally, in claims 35, 41, and 47, the proposed amendment of the claims to recite "a corresponding RNA" and "a corresponding gene" (rather than "their corresponding" RNA/gene, referring back to single, specific sequences) broadens the claims to encompass additional molecules, necessitating further search and consideration. Regarding claim 37, the proposed amendment to the claim such that it requires a probe that "consists of 21 base pairs having a sequence of a region of sequence SEQ ID NO: 2...." requires a specific new search for molecules having particular structural characteristics.

b) Applicant's proposed amendments raise the following new issues under 35 USC 112, first paragraph. Regarding claim 52, Applicant has proposed amending

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the claims such that they encompass hybridization of primers at specific locations on any nucleic acid molecule including "SEQ ID No: 1, SEQ ID No: 2" or "a complement" of either SEQ ID NO: 1 or 2. This amendment necessitates consideration of whether this large genus of target molecules (which has not previously been recited in the claims) is both described and enabled under 35 USC 112, first paragraph.

c) Applicant's proposed amendments raise the following new issues under 35 USC 112, second paragraph. In claim 41, the language "a corresponding RNA sequences selected from the group consisting of SEQ ID No: 1, SEQ ID NO:2 and a corresponding gene of said corresponding RNA sequence" is unclear, because none of SEQ ID NO: 1, SEQ ID NO: 2, or a "corresponding gene" of an RNA are actually composed of RNA. In claim 47, the recitations "said amplified sequences" and "said amplified nucleotide sequences" lack antecedent basis.

2. It is also noted that applicant's proposed amendments if entered would also necessitate the following objections for minor informalities. Claim 37 recites "A nucleotide probe consists of...." rather than, e.g., "A nucleotide probe consisting of" or "A nucleotide probe that consists of..." Claim 47 (in step (3)) recites "a nucleotide probe comprises a sequence..." rather than, e.g., "a nucleotide probe comprising a sequence" or "a nucleotide probe that comprises a sequence."